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**OFFICE OF PETITIONS**

In re Application

Zhang, et al.

Application No. 10/821,565

Filed: April 9, 2004

Dkt. No.: 2637

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: PATENT TERM ADJUSTMENT

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)-(d)," filed April 23, 2009. This matter is being properly considered under 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is either 1,394 or 1,340 days, not 852 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent. Applicants further acknowledge a possible error in the calculation of a 54 day adjustment in reference to the non-final Office action mailed September 24, 2008.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is

advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

The patent term adjustment application fee of \$200.00 is hereby acknowledged. See, 37 CFR 1.18(e).

Applicants further indicate that the adjustment of 54 days accorded in connection with the mailing of the non-final Office action mailed September 24, 2008 may be in error. The adjustment has been reviewed and no error in this regard has been found. A review of the record reveals that a final Office action was mailed February 1, 2008. An amendment in response thereto was filed April 1, 2008. An Advisory Action was mailed May 7, 2008. A Notice of Appeal was filed June 2, 2008. A Pre-Appeals Conference Decision reopening prosecution was mailed July 16, 2008. In compliance with the Board decision, the finality of the February 1, 2008 final Office action was withdrawn and a non-final Office action was mailed September 24, 2008. As prosecution was reopened by virtue of the Board decision mailed July 16, 2008, the reply filed April 1, 2008 was deemed responsive to the February 1, 2008 final Office action. Thus, the Office failed, within the meaning of 37 CFR 1.702(a)(2), to reply to a response under 35 USC 132 within four months. Thus, the adjustment of 54 days was properly accorded pursuant to 37 CFR 1.702(a)(2). The adjustment commenced August 2, 2008, the day after the date that is four months after the date that the reply was filed, and ended September 24, 2008, the date that the non-final Office action was mailed. See, 37 CFR 1.703(a)(3).

In view thereof, as of the time of allowance, an overall adjustment of 852 days was properly determined.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3205.

A handwritten signature in black ink, appearing to read 'A. Brown', written in a cursive style.

Alesia M. Brown  
Petitions Attorney  
Office of Petitions